

determining at approximately the scheduled time if a scheduling conflict exists, the information comprising in-band information including electronic program guide information, the operation of said scheduler being initiated by a user,

wherein if no scheduling conflict exists then the means for powering-on powers-on the tuner and the means for tuning tunes to the scheduled channel at approximately the scheduled time to receive the information associated with the channel, regardless of the presence of the user, and stores the information associated with the channel for subsequent processing, whereby the information may subsequently be retrieved and viewed or used by the user.

43. The information handling system of claim 40, wherein the information further comprises internet-related information.

44. The computerized system of claim 1 wherein the electronic program guide data originates from multiple sources.

45. The computerized system of claim 1 wherein the user initiated scheduling process is capable of causing the real time scheduling process to schedule multiple executions of the caching process.

#### REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on December 19, 2001, and the references cited therewith.

Claims 1, 9, 15, 16, 21, 25, 32, 36, 39, and 40 are amended, no claims are canceled or added; as a result, claims 1-6, 9-13, 15-19, 21-23, 25, 28-32, 35-36, 39-40, and 43-45 are now pending in this application. Support for the amendments can be found throughout the specification, and in particular on page 6, lines 10-17. Applicant believes that no new matter has been introduced with the amendments.

§103 Rejection of the Claims

Claims 1-5, 7, 9-23, 25-27, 29-30, 32-34, 36-38 and 40-42 were rejected under 35 USC § 103(a) as being unpatentable over Young (U.S. 5,353,121) in view of Ohga (U.S. 5,465,385) and Metz (U.S. 5,666,293). Applicant respectfully traverses the rejection, because the cited art does not present a *prima facie* case of obviousness with respect to the amended claims. Further, Applicant notes that claims 7, 14, 20, 26, 27, 33, 34, 37, 38, 41 and 42 were cancelled in the response filed September 24, 2001.

In order to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that the combination of Young, Ohga and Metz fails to teach or disclose each and every element of Applicant's amended claims.

An example of an element not taught in the cited art is found in amended independent claim 1, which recites in part a scheduling process that operates to "determine if a scheduling conflict exists, and if no conflict exists then scheduling execution of a caching process." Amended independent claims 9, 15, 16, 21, 25, 32, 36, and 40 each recite similar language with respect to determining if a scheduling conflict exists. Applicant has reviewed Young, Ohga, and Metz, including performing a computerized text search, and can find no teaching or suggestion of an automated manner of dealing with scheduling conflicts. Applicant's claimed invention thus has the advantage that a scheduled download of data will not interfere with a user's scheduled recording of video content. Because none of Young, Ohga, and Metz, alone or in combination, teach or suggest the recited language, a *prima facie* case of obviousness does not exist with respect to the cited art. The Examiner is therefore respectfully requested to withdraw the

rejection of claims 1, 9, 15, 16, 21, 25, 32, 36, and 40.

Applicant further notes that in the rejection of claim 1, the Office Action states on page 3: "the claimed limitations reciting "in-band data broadcast" is broad enough to read on the system described in Young, wherein the in-data [sic] may be broadcast over a conventional CATV system utilizing a conventional frequency channel, such as a 6 MHZ channel (col. 23, lines 7-15). "In-band" data broadcasts include broadcasts that utilize any or all portions of a frequency channel".

Applicant respectfully disagrees. While Applicant recognizes that limitations from the specification are not imported into the claims, it is also true that an Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Applicant has consistently used the term "in-band data" such as an electronic program guide (EPG), stock data, sports scores etc. to differentiate from audio and video content. The structure of such in-band data (as used by Applicant) is different from audio and video content. Therefore, the term "in-band" data is not as broad as suggested by the Office Action.

Claims 2-5, 10-13, 17-19, 22-23, 29-30 and 41-42 each depend from one of the independent base claims discussed above. Each of these claims therefore inherits the elements of there respective base claim, including recitations directed to determining scheduling conflicts, and add further patentable distinctions. These dependent claims are therefore allowable for the same reasons as discussed above with respect to their base claims.

Claim 6 was rejected under 35 USC § 103(a) as being unpatentable over Young (U.S. 5,353,121) and Ohga (U.S. 5,465,385), in view of Yoshinobu (U.S. 5,686,954). Applicant respectfully traverses the rejection because the cited art does not teach or suggest each and every element of Applicant's claims. Claim 6 depends from claim 1, and therefore inherits the recitation directed to determining if a schedule conflict exists. As discussed above, neither Young nor Ohga teach or suggest the recited language. In addition, Applicant has reviewed Yoshinobu and can find no teaching or suggestion of determining if a scheduling conflict exists. Therefore none of Young, Ohga, and Yoshinobu, alone or in combination, teach each and every

element of Applicant's claims. The Examiner is therefore respectfully requested to withdraw the rejection of claim 6.

Claims 28, 35, 39 and 43 were rejected under 35 USC § 103(a) as being unpatentable over Young (U.S. 5,353,121) and Ohga (U.S. 5,465,385), in view of LaJoie (U.S. 5,850,218). Claims 28, 35, 39 and 43 each inherit recitations from their respective base claims related to determining at approximately the scheduled time whether or not a scheduling conflict exists. As discussed above, neither Young nor Ohga teach or suggest determining if a scheduling conflict exists. LaJoie, in FIG. 12 and at column 21, line 30 to column 22, line 5 mentions conflict checking. However, the conflict checking of LaJoie occurs at the time the scheduling request is initiated by the user, not at the schedule time itself. Further, the conflict checking of LaJoie requires user action to resolve the conflict. Thus Applicant's claimed invention has the advantage that a user can schedule a content recording that can in effect override a data download. The data download can occur at the next scheduled time (assuming there is no conflict at the later time). As a result, none of the cited references, alone or in combination, teaches determining if a scheduling conflict exists at approximately the scheduled time. The Examiner is therefore respectfully requested to withdraw the rejection of claims 28, 35, 39, and 43.

Claim 44 was rejected under 35 USC § 103(a) as being unpatentable over Young (U.S. 5,353,121) and Ohga (U.S. 5,465,385) as applied to claim 7 above, and further in view of Klosterman (U.S. 5,550,576). Applicant traverses the rejection because the cited art does not teach or suggest each and every element of Applicant's claims. Further, Applicant notes that claim 7 is no longer pending in the application and was not discussed in the Office Action. Like the claims discussed above, claim 44 inherits the recitation of determining if a scheduling conflict exists. As discussed above, neither Young nor Ohga teach or suggest the recited element. Further, Applicant has searched Klosterman, and can find no teaching or suggestion of the recited language. Therefore the cited art, alone or in combination, does not teach or suggest each and every element of Applicant's claim 44. The Examiner is respectfully requested to withdraw the rejection of claim 44.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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Date Apr. 19, 2002

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 19th day of April, 2002.

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